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Richard L. Mayer
KENYON & KENYON
One Broadway
New York, N.Y. 10004

In re Application of:
SUSEN ET AL.
Application No.: 09/786,819
PCT No.: PCT/EP99/06371
Int. Filing Date: 30 August 1999
Attorney's Docket No.: 22345/147
For: METHOD FOR VERIFYING ACCESS AUTHORIZATION FOR VOICE TELEPHONY
IN A FIXED NETWORK LINE OR MOBILE TELEPHONE LINE AS WELL AS A
COMMUNICATIONS NETWORK

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: DECISION ON
: PETITION
: UNDER 37 CFR 1.137(b) AND
: UNDER 37 CFR 1.47(a)
:

This is in response to the petition under 37 CFR 1.137(b) to revive the above-identified abandoned application for "unintentional" delay and the petition under 37 CFR 1.47 (a) to accept the above-identified national stage application without the signature of co-inventor Axel SUSEN both filed 28 November 2001. Applicant's correspondence provided authorization to charge their deposit account (No. 11-0600) the fee of \$1,280.00 set forth in 37 CFR 1.17(m) for the petition under 37 CFR 1.137(b) and the fee of \$130.00 set forth in 37 CFR 1.17(h) for the petition under 37 CFR 1.47(a).

BACKGROUND

On 30 August 1999, applicant filed international application PCT/EP99/06371, which claimed priority to an earlier German application DE 198 41 166.9, filed 09 September 1998. A Demand for international preliminary examination, was timely filed. Accordingly, the thirty month period for paying the basic national fee in the United States expired at midnight on 09 March 2001.

On 09 March 2001, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and an unsigned inventor Declaration.

On 27 April 2001 the United States Designated/Elected Office (DO/EO/US) forwarded a Notification of Missing Requirements under 35 USC 371 (Form PCT/DO/EO/905) requiring the submission of an executed oath or declaration conforming to 37 CFR 1.497(a) and (b) properly identifying the application and the late surcharge fee pursuant to 37 CFR 1.492(e) within two months of the mailing date (e.g. 27 June 2001).

On 28 November 2001 the present petition under 37 CFR 1.137(b) to revive the above-identified abandoned application for "unintentional" delay and the petition under 37 CFR 1.47 (a) to accept the above-identified national stage application without the signature of co-inventor Axel SUSEN was submitted. These petitions further included a copy of the Transmittal of Missing Requirements along with a Declaration and Power of Attorney executed by inventor Stefan BROCK.

DISCUSSION

I. Petition To Revive under 37 CFR 1.137(b):

A petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, (2) the petition fee required by 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional, and (4) a terminal disclaimer with disclaimer fee (only for utility and plant applications filed before 08 June 1995).

Regarding item (1), applicants furnished the present petition under 37 CFR 1.47(a).

Regarding item (2), on 28 November 2001, applicants submitted the petition fee required by 37 CFR 1.17(m) of \$1,280.00

Regarding item (3), on 28 November 2001, applicants submitted a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

Regarding item (4), because applicants' filing date of 30 August 1999 is after 08 June 1995, the requirement of a terminal disclaimer with disclaimer fee is not applicable in this case.

Accordingly, applicants' petition to revive conforms with Rule 137(b) and therefore, applicants' attached response to the Notice of Missing Requirements (e.g. the Transmittal of Missing Requirements, a copy of the Notice of Missing Requirements) and the Petition Under 37 CFR 1.47(a) with accompanying attachments (including a Declaration and Power of Attorney executed by inventor Stefan BROCK but lacking the signature of inventor Axel SUSEN) are hereby entered.

The merits of applicant's Petition under 37 CFR 1.47 (a) to accept the above-identified national stage application without the signature of co-inventor Axel SUSEN will now be considered.

II. Petition to File When An Inventor Refuses To Sign or Cannot Be Reached under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Applicant have satisfied items (1), (3), and (4) above.

Regarding item (2) above, MPEP 409.03(d) (August 2001) states in part:

Where inability to find or reach a nonsigning inventor “after diligent effort” is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included ... (I)t is important that the statement contain facts as opposed to conclusions.

The supporting documentation submitted with the petition included a Declaration by an attorney of record (hereinafter an attorney statement), Linda M. Shudy, that, based upon the information received from Deutsche Telekom AG, that after due diligence the joint inventor Axel SUSEN (hereinafter the non-signing inventor) was not located.

The statement of Ms. Shudy and evidence provided under 37 CFR 1.47(a) are insufficient to demonstrate the “factual proof” required under 37 CFR 1.47(a). Specifically, the statement of facts provided in the petition is not signed by a “person having firsthand knowledge,” which is necessary since hearsay statements are not acceptable proof.

Furthermore, evidence of a single mailing to the nonsigning inventor’s last known address does not constitute “diligent effort” to locate the nonsigning inventor. This is especially true where, as in the present case, there has been no returned mail evidencing that Axel SUSEN is not available.

Applicant must demonstrate other additional efforts made to locate the nonsigning inventor, e.g. internet search, telephone directory search, checking with the local postal authority to determine the existence of a forwarding address, etc.

These additional efforts to locate the non-signing inventor are necessary in order to establish that the inventor is not "on vacation or out of town and is therefore temporarily unavailable to sign the declaration" or is not "hospitalized and/or is not conscious" which are not acceptable reasons for filing under 37 CFR 1.47. See MPEP 409.03(d).

In that Item (2) has not been satisfied, the present petition under 37 CFR 1.47(a) may not properly be granted at this time.

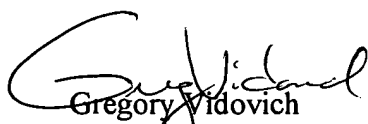
CONCLUSION


The petition under 37 CFR 1.137(b) is **GRANTED**.

For the reasons above, the petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Failure to timely submit the proper reply will result in **ABANDONMENT**. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner of Patents, Box PCT, Washington, D.C., 20231, with the contents of the letter marked to the attention of the PCT Legal Office.


Gregory Vidovich
PCT Legal Detailee
PCT Legal Office


Richard Cole
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 308-1315
Facsimile: (703) 308-6459